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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,620	04/19/2001	David B. Orchard	CA920000010US1	3584

7590

05/19/2005

IBM Corporation  
Intellectual Property Law, Dept. 917  
3605 Highway 52 North  
Rochester, MN 55901

EXAMINER

RUTTEN, JAMES D

ART UNIT

PAPER NUMBER

2192

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 09/838,620	Applicant(s) ORCHARD ET AL.	
	Examiner J. Derek Rutten	Art Unit 2192	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1,3,5-8,17,19,21,22,25-27 and 37.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☒ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

WEI Y. ZHEN  
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because:

37 CFR 1.116(e) recites: "An affidavit or other evidence submitted after a final rejection ...may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented." This requirement has been waived, and the declaration has been considered. However, future submissions after a final rejection must present "good and sufficient reasons" as required by 37 CFR 1.116(e), or the declaration will not be considered.

Applicant's declaration is not signed by all named inventors. While it is signed by Arvind Viswanathan, it is not signed by David Orchard. Declarations that are not signed by all named inventors are only acceptable in limited circumstances, none of which have been established here. See MPEP 715.04(I).

Applicant's declaration filed under 37 CFR 1.131 attempts to establish prior invention by way of reduction to practice. Prior invention requires a showing of facts sufficient to show: (a) reduction to practice; or (b) conception of the invention coupled with due diligence (See MPEP 715.07(III)). Applicant's declaration also introduces conception of the invention; however, prior invention by way of conception of the invention also requires a showing of due diligence, and there is no showing of facts regarding due diligence, apparently due to the claim of reduction to practice which does not require due diligence. Applicant claims that reduction to practice occurred prior to January 14, 2000 and provides a document dated October 25, 1999 as evidence. A statement in the last line of this document is used to support reduction to practice prior to October 1998 through implementation of "IBM StudentServer project". However, the declaration fails to recite sufficient facts for the examiner to determine which of the claim limitations were satisfied by the IBM StudentServer project, whether the project represented realistic conditions for use of the tool, successful results, or reproducible results. Further, applicant's statement in the paragraph starting on page 2 and continuing to page 3 of the declaration, that the invention was reduced to practice, is unsupported by proof or a showing of facts. A general allegation that the invention was completed prior to the date of the reference is not sufficient. Therefore, the declaration does not satisfy the requirements of 37 CFR 1.131(b).

Claims 1,3,5-8,17,19,21,22,25-27 and 37 remain rejected under 35 USC 102(e) as anticipated by US Patent Publication 2004/00123302 A1 by Lo et al. which claims priority to earlier application number 09/483,069 filed on January 14, 2000 as applied in the Final Office Action dated 6 January 2005.